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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,371	09/10/2003	Robert L. Doubler	ZMS-G03US	6685
43541 7590 03/26/2007 WOOD, HERRON & EVANS (ZIMMER SPINE) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/661,371

Applicant(s)

DOUBLER ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-25 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,7-9,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Species III, corresponding to the embodiment shown in Figure 15, in the reply filed on 27 December 2006, is acknowledged. Because applicant did not distinctly and specifically point out any supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant indicated that claims 1, 5, 6 and 13-25 read on the elected species. Accordingly, claims 3, 4, 7-9, 11 and 12 have been withdrawn from further consideration as being drawn to a non-elected invention.

Specification

Regarding the Abstract, the introductory phrase "The present invention provides" should be avoided as it can be inferred.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 16, 17, 19 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Freedland et al. (6,162,234, cited by Applicant).

Freedland et al. disclose a device comprising a tapered collet 12 and compression ring 14 and a shank member (see, e.g., Figs. 23-34). The shank and inner

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engaging surface interface may be threaded or knurled (e.g. 1111, Fig. 25 or 111A, Fig. 34). Both the shank and the inner surface include smooth portions that are capable of being engaged. A first revolution of the thread can be considered a lip corresponding to a groove (the mating thread form). It is noted that an embodiment also includes an inner groove 121A--Fig. 33). The shank includes a tensioning end and the shank is frangible (see Fig. 34). The device may be formed of steel or plastic (see, e.g., column 25, lines 61-67). It is noted that the shank member is at least capable of being placed into tension (for example, by pulling on or prying the same) when the collet member is in a release position, and can accordingly be considered to have the claimed "configuration." Regarding claim 16, the portion of the stem that may be sawn off can inherently be considered to be a frangible stem since it is at least capable of being broken off, for example by rotational or translational sheering.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 18, 20-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedland et al. (6,162,234., cited by Applicant).

Freedland et al. disclose the claimed invention except for explicitly disclosing that the tensioning means can comprise a groove or a threaded bore and that the device

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could be formed of copper, brass, bronze, aluminum or rubber. However, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted a groove or a threaded bore for the tensioning means of Freedland et al. as this would merely have been the substitution of functionally equivalent fastening or gripping means known in the art. Likewise, it would have been obvious to have substituted wrench flats on the outer surface of the compression ring. It also would have been obvious to have formed the compression ring of copper, brass, bronze, aluminum or rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 11 September 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Freedland et al. fail to disclose the claimed limitations including the limitations incorporated into independent claim 1 from canceled claims 2 and 10, it is noted that these limitations can be considered to be directed to an intended use, as set forth in the rejection, since the prior art structure is at least capable of satisfying these limitations. For example, any portion of the shank member is at least capable of being gripped, such that it may be considered to have "an outer gripping portion." Likewise, it was noted in the rejection that the shank member is at least capable of being placed into tension (for example, by pulling on or prying the

same) when the collet member is in a release position, and can accordingly be considered to have the claimed "configuration." Regarding claim 16, the portion of the stem that may be sawn off can inherently be considered to be a frangible stem since it is at least capable of being broken off, for example by rotational or translational sheering.

Applicant did not separately address the merits of the rejection under 35 USC 103(a).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER